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In The

U.S. PATENT & TRADEMARK OFFICE

**United States Court of Appeals
For The Federal Circuit**

IN RE WILHELM ELSNER

**APPEAL FROM THE
UNITED STATES PATENT AND TRADEMARK OFFICE,
BOARD OF PATENT APPEALS AND INTERFERENCES.**

REPLY BRIEF OF APPELLANT

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SUMMARY OF THE ARGUMENT

The claim to 'Pendec' is rejected for anticipation by a published listing of a Plant Breeders' Rights Application (PBR) on 'Pendec' along with its botanical classification in view of a sale of 'Pendec' in Germany, both activities occurring more than a year before the United States filing date. This rejection is flawed because the foreign commercial activity did not bar patenting of 'Pendec' by statute or precedent. The published listing of the 'Pendec' PBR cannot be an enabling prior art reference according to the rule set forth *In re LeGrice*, 301 F.2d 929, 936 (C.C.P.A. 1962), regardless of the current attempt by Appellee to consider the foreign sale as information that evidences enablement of the PBR listing.

ARGUMENT

I. FOREIGN COMMERCIAL ACTIVITIES ARE NOT BARRED BY STATUTE OR PRECEDENT AND CANNOT BE RAISED TO THE LEVEL OF A STATUTORY BAR

At issue is whether a printed publication listing a plant variety anticipates a claim to that plant when there is evidence of prior public access to the plant outside the United States.

A. Elsner's Claim Cannot Be Barred By "Public Possession" Of The Invention That Occurred Outside The United States

The geranium 'Pendec' appeared in a 1997 listing of Community Plant Breeders' Rights applications by its name and application number. (A82-83). 'Pendec' plants were sold in Germany in 1998. (A6). Some portion of the worldwide public had actual possession of the plants, but that public was not in the United States. Hence the "public" which had actual possession was in Germany and was not within the public domain specified by § 102(b). It is improper for the United States Patent and Trademark Office (USPTO) to assert that 'Pendec' was "in the public domain more than one year prior to its U.S. filing date". USPTO Br. at 13-14.¹ The public access to 'Pendec' outside the United States prior to its U.S. filing date is simply not prior art under § 102(b) and cannot be raised to the level of a statutory bar by the USPTO. The claim rejection in the present case represents an improper interpretation of the law governing novelty in the United States. This new standard of patentability was created *sua sponte* by the Plant Patent Examining Group. It has no basis in law as explained by this Court and is counter to the USPTO's decades of examination practice.

¹ Citations to Appellant's brief will be referred to as "USPTO Br. at ____".

B. Holding For Appellant Is Consistent With The Policies Of 35 U.S.C. § 102(b) That Encourage Patent Filing Once An Invention Is Placed In Commerce In The United States

To the extent that 35 U.S.C. § 102(b) encourages inventors to file for patent protection promptly after commercialization of their inventions, the commercialization of concern is limited to activities in the United States. The statute bars patenting an invention that “was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country”.

Id.

According to the Appellee, Director of the United States Patent and Trademark Office (referred herein as the USPTO), the long standing policies of requiring that an inventor file for patent protection within one year of commercialization (or other public use) would be defeated by an inventor publishing (describing but not enabling) an invention, commercializing the invention outside the United States and seeking patent protection more than one year after such publication and foreign commercialization. USPTO Br. at 13. No support for such a scenario can be found, so instead, the USPTO cites to several cases involving activity by the inventor in the United States, not in foreign countries. In particular, *Metallizing Engineering Co., Inc., v. Kenyon Bearing & Auto Parts Co., Inc.*, 153 F.2d 516 (2d Cir. 1946) determined whether prior secret use of an invention in the United States invalidated a patent, and both of *Seal-Flex*,

Inc. v. Athletic Track and Court Construction, 98 F.3d 1318 (Fed. Cir. 1996) and *Ferag AG v. Quipp, Inc.*, 45 F.3d 1562 (Fed. Cir. 1995) dealt with sales of patented inventions in the U.S. Naturally, these cases contain language on the need for inventors to file patent applications prior to commercialization, but only for activities in the United States. *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368 (Fed. Cir. 1998) includes a passage that merely repeats this policy.

Appellant Elsner does not dispute the legion of authority that the purpose of the final clause of § 102(b) is to limit the length of time an inventor has before applying for a patent after the subject invention has been in public use or on sale in this country. The proper focus here should not be on the policy attendant the § 102(b) public use/on sale in the United States time bar.

Finally, the USPTO relies on *In re Bayer*, 568 F.2d 1357 (C.C.P.A. 1978) which dealt with the date of actual publication of a student thesis deposited in a university library but not disseminated or readily available to the public. The *Bayer* court sought to determine if the student thesis was a prior art reference. Hence, the court opined that “[t]he date on which the public actually gained access to the invention by means of the publication is the focus of inquiry”. *Id.* at 1361. That passage taken in proper context refers to the date of actual publication, i.e., access of the student thesis to the public and cannot be read to indicate that a publication can be the means to “access” an invention such as in a research trail to

find a 'Pendec' plant in use outside the U.S. There are no factual parallels from the above-mentioned § 102(a) and (b) cases or *Bayer* to the present case. The isolated case law passages cited by the USPTO are irrelevant to the issue at hand.

While § 102(b) clearly creates a time bar following public use or sale of an invention in the United States, the very same type of public use or sale in a foreign country is not barred. There can be no implicit policy that an inventor's publication and foreign use or sale is counter to the provisions of § 102(b) which allow for essentially unlimited foreign use/sale prior to patenting in the United States. Allowance of Elsner's patent claim will not run counter to the policies attendant § 102(b).

C. A Publication On A Plant Variety Can Inform Where To Obtain The Plant But Cannot Provide "Possession Of The Invention"

A printed publication is a statutory bar if a skilled artisan can take its teachings in combination with the artisan's own knowledge of the relevant art and be "in possession of the invention". *In re LeGrice*, 301 F.2d 929, 936 (C.C.P.A. 1962). The USPTO improperly equates the ability to "possess" or have access to a 'Pendec' plant in Germany with the "possession of the invention" test for enablement of a publication in *LeGrice*. USPTO Br. at 16. Moreover, the USPTO provides no support for its assertion that a printed publication is enabled if the public can possess the invention listed therein by access to the invention anywhere in the world. USPTO Br. at 14.

Additional evidence may be used to show that the subject matter of a publication was in the public's possession when another piece of statutory prior art indicates that the subject matter was in fact producible by some means. See *In re Samour*, 571 F.2d 559 (C.C.P.A. 1978); *In re Donohue*, 766 F.2d 531 (Fed. Cir. 1985); and *In re Sheppard*, 339 F.2d 238, 242 (C.C.P.A. 1942). An additional reference (a piece of true statutory prior art) can be used to show what the publication means to skilled artisans, but not to fill in what is missing in the publication. *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565 (Fed. Cir. 1991).

The USPTO asserts that *Samour* and *Donohue* stand for a proposition that "[p]hysical possession of a claimed invention, compound or plant resolves any question about whether one can recreate the thing by way of instructions." USPTO Br. at 6. Neither case propounds any such rule. Instead, both found enablement of a publication on a chemical compound by a secondary piece of prior art that taught how to produce the compound. In fact, *Donohue* downplays any importance of physical possession of by stating that "[i]t is not, however, necessary that an invention disclosed in a publication shall have actually been made in order to satisfy the enablement requirement." *Id.* at 533. Physical possession is not even mentioned in *Samour*. There is no specific precedent for a concept of "constructive" possession as set forth by the USPTO (USPTO Br. at 14).

Moreover, possession of the invention described in a printed publication is found “if one of ordinary skill in the art could have combined the publication’s description of the invention with his own knowledge to make the claimed invention.” *Elan Pharmaceuticals, Inc. v. Mayo Foundation for Medical Education and Research*, 346 F.3d 1051, 1055 (Fed. Cir. 2003), (emphasis added), citing *Donohue*. While that familiar language from *Donohue* and *LeGrice* appears in *Elan*, that case is not on point. The issue in *Elan* was whether undue experimentation would be required to produce a transgenic mouse having a mutated gene based on information regarding that particular gene in printed publication. There was no issue in *Elan* (as in *Samour*, *Donohue* or the present case) of the ability of additional prior art to enable the publication.

The USPTO cannot rely on *Samour* and *Donohue* to support an assertion that the “actual objects that are publicly available are evidence that must be considered”. USPTO Br. at 26. Those cases allowed secondary references (true statutory prior art) to explain how a published compound could be made. The sale of ‘Pendec’ in Germany does not explain how to be in possession of the plant listed in the PBR application. The PBR application could only provide information on how to obtain a plant outside the United States, which is not a statutory bar, under 35 U.S.C. § 102(b) and it is counter to the rule of *LeGrice*.

Elsner does not dispute the use of research in examination of plant patent applications. However, the research performed by the USPTO led only to a non-enabling listing of 'Pendec' as a PBR application and a foreign sale of 'Pendec'. Neither are anticipatory under § 102(b). Importing the foreign sale into the PBR listing of plant varietal name and botanical classification as evidence of possession of the invention amounts to an improper sidestep of § 102(b).

The USPTO's reliance on *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560 (Fed. Cir. 1988) for permitting sales information to assess enablement is misplaced. USPTO Br. at 29. In *Constant*, a publication on a patented computer chip was found enabling, not because the chip itself was sold previously, but because a kit for programming the chip had been on sale. In other words, the sale of the kit was a secondary reference explaining how to make operational the patented chip described in the prior art. More importantly for the Court was the fact that the patent claims did not require, nor did the patent even disclose, the necessary programming. *Id.* at 1569. As such, the publication was at the same technical level of detail as the patent. *Id.* The chip was not anticipated by the publication about the chip combined with a sale or public access of the chip. Anticipation was found because the publication's disclosure matched the claimed subject matter.

In the present case, the listing of a PBR application number for 'Pendec' can in no way be said to be on the same level of technical detail as that of the rejected claim. In fact, no description of a plant can be at the same level as a plant patent claim. *LeGrice* at 939.

D. Actual Possession Of The Claimed Plant Outside The United States Is Irrelevant To Anticipation Under § 102(b)

Not only does the foreign sale of 'Pendec' fail as prior art under § 102(b), but its use in the present case to supplement the non-enabling nature of a publication listing a plant name and its Plant Breeders' Rights Application number is counter to precedent. The sale of 'Pendec' in Germany simply is not prior art. The USPTO is attempting to convert that foreign sale into a barred § 102(b) event under the guise of showing enablement of a printed publication by the foreign sale. There is no precedent cited by the USPTO that supports enablement of a publication based on the foreign accessibility of an invention. To the contrary, the invention described in a publication must be capable of being made or produced by the public to show possession. *Samour* at 564, *Donohue* at 533.

Elsner does not seek to exclude the public from practicing the prior art. The prior art does not include a foreign sale of 'Pendec'. Publication plus foreign public availability together are not an anticipation of an invention. The USPTO's assertion thereof is unsupportable. USPTO Br. at 16. There is no "§ 102(b) possession test" as propounded by the USPTO. The public's access to

'Pendec' outside the United States does not put the plant "in the public domain" for the purposes of § 102(b). The USPTO has blurred the *LeGrice* "in possession of the invention" test for enablement of a publication with actual possession in the United States or elsewhere. This focus on actual possession outside the United States is misplaced.

E. The *LeGrice* "Possession" Test Is Different From The Need For Physical Access To Biological Materials In Utility Patents

The *LeGrice* test for "possession" of the invention has nothing to do with physical access to an invention. Instead, that test determines that the disclosure of printed publication is a statutory bar when "a skilled artisan could take its teachings in *combination with his own knowledge of the particular art and be in possession of the invention*". *LeGrice* at 936, emphasis in original. The "invention" is not the ability to obtain a physical sample of the claimed subject matter. Instead, an "invention" under Title 35 "unquestionably refers to the inventor's conception rather than to a physical embodiment of that idea." *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55, 59 (1998). An invention need not be reduced to practice to constitute patentable subject matter. *Id.*

Likewise, with the clear exception of utility patent applications on biological materials (under the Budapest Treaty, not here applicable), there is no requirement that the starting materials for an invention be provided to the public to enable a patent thereon under 35 U.S.C. § 112. The USPTO argues that the deposit

requirement for enablement of patents on biological materials would be consistent with holding that a non-enabling printed publication on a plant is enabled via foreign public access to that plant outside the United States. USPTO Br. at 20. In essence, the USPTO considers the foreign sale of a plant to be a "deposit" for the purposes of enabling a publication under § 102(b) akin to the deposit required for patenting biological utility inventions.

The issues relating to the deposit requirement in biological utility patents resolved in *In re Argoudelis*, 434 F.2d 1390 (C.C.P.A. 1970) (deposit due at issuance of patent) and *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 323 F.3d 956 (Fed. Cir. 2002) (incorporation by reference of deposit of nucleotide sequences meets written description requirement) are unrelated to the present issue of enablement of a prior art reference. Likewise, the ability to fulfill the deposit requirement in a foreign location is not at issue here as was considered by *Ajinomoto Co., Inc. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338 (Fed. Cir. 2000), *Feldman v. Aunstrup*, 517 F.2d 1351 (C.C.P.A. 1975) and *Ex parte Rinehart*, 10 U.S.P.Q.2d 1719 (Bd. Pat. App. & Inter. 1989). None of these cases relied upon by the USPTO have any bearing on the issue here of enabling a printed publication. They all relate to the deposit requirement for biological materials that is in place to satisfy the enablement standards of § 112.

F. In The Absence Of A Deposit Requirement For § 112 Enablement Of Plant Patents, A "Deposit" Of A Plant Is Not Proper Enablement Of A Publication Thereon

Biological utility patents require a deposit of the subject biological material for enablement under 35 U.S.C. § 112; plant patents do not. To the extent that enablement of biological utility subject matter is related to anticipatory prior art thereon, that relationship does not affect enablement of a plant patent and its corresponding prior art. The degree to which an anticipatory reference must be enabled is tied to the level at which the patent claim is enabled under § 112. *Constant* at 1569; *In re Paulsen*, 30 F.3d 1475, 1481, n.9 (Fed. Cir. 1994). If the disclosure in a publication of certain details of a device is essential to show anticipation, then a patent disclosure lacking those details would fail to satisfy § 112 requirements. *Id.*

For biological utility patents that require a deposit for § 112 enablement, an anticipatory reference would likewise require a "deposit" to allow public access to the biological material. *Id.* Accordingly, if the disclosure in a publication on a plant requires public access to the plant to anticipate a plant patent claim, then a claim to that plant unaccompanied by public access to the plant would not be enabled under § 112. *Id.* Yet, while a deposit (public access) is required for a biological utility patent, there is no deposit requirement for plant

patents. Thus, the USPTO's position that it is proper to "enable" a publication on a plant by looking to its accessibility by the public is unsupportable.

In *LeGrice*, this Court's predecessor declined to relax the enablement requirement of a printed publication for anticipation of a plant to parallel the relaxed § 112 plant patent enablement requirement because no statutory allowance is made in § 102(b) regarding the sufficiency of description in plant publications. *LeGrice* at 944. A holding in the present case that the cited PBR publication cannot be enabled by public access to the plant outside the United States does not represent a relaxation of the standards in § 102(b). In fact, it will be consistent with the absence of a deposit requirement for plant patents. The plant patent claim requires no public access for its enablement under § 112, therefore it is not proper to assert that public access to the plant enables a publication thereon.

G. Infringement May Be Shown By Access To The Plant, But Access Does Not Necessarily Anticipate

Contrary to the assertions by the USPTO, there is no "established possession test" by which anticipation is determined. USPTO Br. at 22. Elsner does not dispute that the claim reads on the 'Pendec' plant sold in Germany more than one year before the U.S. filing date or that infringement of that claim requires asexual reproduction of a 'Pendec' plant under the test enunciated in *Imazio Nursery, Inc. v. Dania Greenhouses*, 69 F.3d 1560 (Fed. Cir. 1995). However, *Imazio* does not go so far as to say that anticipation cannot be found in an

independent invention of 'Pendec'. Likewise, Elsner does not argue that an anticipation can only be proven by independent creation of a 'Pendec' plant.

There is no dispute by either party here that the PBR publication cannot put a skilled artisan "in possession of the invention." If anticipation exists, it must arise from some other source such as public use or sale of the plant in the United States. The USPTO equates possession of 'Pendec' with the claim to 'Pendec' since *Imazio* held that infringement is shown only by possession, i.e., via asexual reproduction. USPTO Br. at 23. Apparently, the USPTO is relying on the adage of "that which anticipates, infringes", a technique for testing infringement based on whether the infringing article would have anticipated the claim. A more precise wording would be "that which anticipates in the U.S., infringes in the U.S." That more precise infringement test should now make clear that only United States access to the infringing article could be compared to anticipation in the United States. Therefore, foreign access is as irrelevant to anticipation as it is to infringement.

II. *LEGRICE* ALREADY CONFRONTED THE ISSUE OF THIS CASE AND DETERMINED THAT A PRINTED PUBLICATION ON A PLANT CANNOT BE ENABLING

A. The *LeGrice* Court Ruled On The Question Of How A Plant Publication Could Be Enabled

The USPTO misconstrues the issue here as being one of first impression, USPTO Br. at 1, of whether a printed publication describing a plant

plus the plant's public availability bars a plant patent applied for over one year later. While the *LeGrice* opinion did not phrase the issue therein precisely the same, the factual basis for the *LeGrice* decision is aligned with the present case.

The USPTO incorrectly states that the issue decided in *LeGrice* was "whether a printed publication must be enabling at all, not the question of how or in what manner a printed publication can be enabling." USPTO Br. at 31, emphasis added. The *LeGrice* opinion concludes with a holding that "descriptions in printed publications of new plant varieties, before they may be used as statutory bars under 35 U.S.C. § 102(b), must meet the same standards which must be met before a description in a printed publication becomes a bar in non-plant patent cases". *Id.* at 944. This particular holding indicates consideration in *LeGrice* of an issue of whether a plant publication must be enabling to bar patenting under § 102(b).

However, the Court in fact went much further. The stated issue was "whether as a matter of law, the English publications constitute, within the meaning of 35 U.S.C. § 102(b), a bar to appellant's right to patents on said applications." *Id.* at 930. After a thorough analysis of the state of the art of asexual plant reproduction and of the requirement of a publication to put the public in possession of an invention, the Court concluded that the publications were "incapable of placing these roses in the public domain by their descriptions when

interpreted in the light of the knowledge now possessed by plant breeders.” *Id.* at 944. Quite clearly, the question before the Court was how a publication could be enabled, not just that it needs enablement to act as prior art.

B. The Rule Of *LeGrice* Is That No Publication Can Be Enabled As Prior Art To A Plant Patent And Should Be Followed Here

The legal issue decided in *LeGrice* was whether a printed publication could be enabled as prior art to a plant patent. After explaining that the § 102(b) standard is not relaxed for plant patents (*Id.* at 932-933), the Court directly addressed how a publication could put the public in possession of the invention. The *LeGrice* Court repeatedly explained that possession of the invention from publication would need to “teach a skillful mechanic some process of making it” (*Id.* at 934) or to “make, construct, and practice the invention” (*Id.* at 936), citations omitted. The Court specifically validated the appellant’s argument that the publications were not sufficient for a skilled breeder to “practice the invention and produce the disclosed varieties”. *Id.* at 936. A major portion of the opinion is dedicated to the technical impossibility of practicing the invention and producing the disclosed varieties from a publication. *Id.* at 936-938. This impossibility stems from the inherent differences between plants and manufactured articles. *Id.* at 935. Behind all of the Court’s analysis of enablement of a plant publication was the factual backdrop of foreign commercial activity of the plants. *Id.* at 931-932. The

doctrine of *stare decisis* requires that the present case, with remarkable factual parallels to *LeGrice*, follow the rule of *LeGrice*.

Following of precedent is imposed to ensure consistency in the law. *Flowers v. United States*, 764 F.2d 759, 761 (11th Cir. 1985). A holding here for Elsner will maintain the law established in *LeGrice*. To hold against Elsner will overturn *LeGrice*.

The cases relied upon by the USPTO are far astream from the highly significant parallels between *LeGrice* and the present case. In *Beacon Oil Co. v. O'Leary*, 71 F.3d 391, 395 (Fed. Cir. 1995), the appellant raised issues that were not litigated or resolved in a prior related case because of factual differences between the cases. Stipulated facts from the prior case could not have been used to confront an issue and factual differences resulted in an argument different from the issue in *Beacon Oil*. *Id.* In both *LeGrice* and here, the stipulated facts include identity between the claimed plants and the published plants and evidence includes foreign commercial availability of the plants. *Id.* at 931-932. The fact pattern here that directly parallels *LeGrice* means that the legal issue here of how a plant patent is enabled was addressed by *LeGrice*.

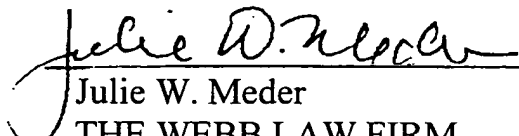
Likewise, while controlling precedent must have confronted and decided the same issue, *Special Devices, Inc. v. OEA, Inc.*, 269 F.3d 1340, 1346, (Fed. Cir. 2001), to fail as precedent that issue cannot have been raised at all in the

prior case. The issue of the mechanism of plant publication enablement was completely confronted and decided by *LeGrice*. It would make no sense to maintain the *LeGrice* decision, yet hold against Elsner when their factual settings are almost identical and their legal issues are the same. The *LeGrice* Court found enablement of a plant publication was technically impossible and there can be no change today to that conclusion. The foreign commercial availability of the plants was not ignored; those facts were stipulated on the record. *Id. at 931-932*. Any potential for the foreign commercial availability to enable the publications of *LeGrice* was not lurking in the record, with no attention paid thereto. It was clearly set forth. Hence, *stare decisis* dictates that the present case (and similarly positioned cases of non-enabling publication with foreign access to the plant) must receive the same treatment as in *LeGrice*. *Flowers at 761*.

CONCLUSION

For the foregoing reasons, Claim 1 of the present patent application is patentable under 35 U.S.C. § 102(b) and the Board's holding of anticipation must be reversed.

Respectfully submitted,


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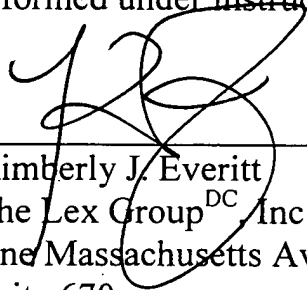
CERTIFICATE OF FILING AND SERVICE

I hereby certify that on January 13, 2004, two (2) true and correct copies of the foregoing Reply Brief of Appellant were served by United States First Class Mail, postage prepaid, on counsel as noted below. Also on this date the original and eleven (11) copies of the Brief were provided to the Court by hand delivery.

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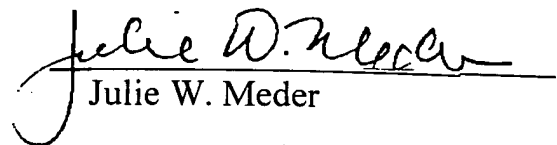
CERTIFICATE OF COMPLIANCE

Pursuant to Federal Rule of Appellate Procedure 32(a)(7)(C), the undersigned certifies that this brief complies with the type-volume limitations of Federal Rule of Appellate Procedure 32(a)(7)(B)(i).

1. Exclusive of the exempted portions of the brief, as provided in Fed. R. App. Proc. 32(a)(7)(B)(iii), this brief includes 4,343 words.

2. This brief has been prepared in proportionally spaced typeface Microsoft Word 97 in 14 point Times New Roman font. As permitted by Fed. R. App. Proc. 32(a)(7)(C), the undersigned has relied upon the word count of this word-processing system in preparing this certificate.

Dated: January 13, 2004


Julie W. Meder